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In re Application of
LINDBO
Application No.: 09/445,843
PCT No.: PCT/SE98/01316
Int. Filing Date: 03 July 1998
Priority Date: 24 July 1997
Attorney's Docket No.: 639321.0004(MIII-102)
For: INTERNET CACHING SYSTEM

DECISION ON
PETITION
UNDER 37 CFR 1.47(b)

This is in response to the petition under 37 CFR 1.47(b), filed 24 July 2000 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing sole inventor, Sverker LINDBO. The \$1850 fee for extension of time of five months under 37 CFR 1.136(a) was charged to applicant's deposit account 11-0231.

BACKGROUND

On 03 July 1998, applicant filed international application No. PCT/SE98/01316 which claimed a priority date of 24 July 1997, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 04 February 1999.

On 18 February 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. As a result, the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was to expire 30 months from the priority date, at midnight 24 January 2000.

On 14 December 1999, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*,: basic national filing fee and an unsigned declaration.

On 11 February 2000, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor must be furnished within one month from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 24 July 2000, petitioner filed the instant petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was accompanied by a Combined Declaration and Power of Attorney signed by Timo Aittola, Chief Financial Officer for applicant Mirror Image Internet, Inc. on behalf of the non-signing inventor. Also submitted was a Declaration under 37 CFR 1.147(b) signed by Mr. Aittola as to facts demonstrating proprietary interest of applicant and a statement of facts of George N. Chaclas, attorney for applicant. Also accompanying the petition was a copy of the "Agreement on the Sale and Purchase of a Business Operation, which assigns the subject application to Mirror Image Internet", an e-mail from the nonsigning inventor to applicant's attorney, 22

March 2000 letter from Mark Shub, Mr. Lindbo's attorney, to applicant's attorney and a untranslated document dated 24 September 1997.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has satisfied items (1) and (2) with payment of the requisite petition fee and a statement of the last known address of the inventor.

As for item (4), petitioner provided a Combined Declaration under 37 CFR §1.63 and Oath/Power of Attorney executed on behalf of the sole inventor by Timo Aittola as Chief Financial Officer of Mirror Image Internet, Inc. However, this declaration fails to comply with 37 CFR 1.497 and 1.63, as it fails to include the statements required under 37 CFR 1.497(a)(4) and 1.63(a)(4).

With regard to item (2), petitioner has not provided adequate proof that the sole inventor refuses to sign the application. Specifically, Mr. Lindbo's 05 May 2000 e-mail to Mr. Aittola clearly states:

Until such matter is resolved, I will not sign any documents in favor of Mirror Image Internet, Inc. in relation to these patents.

Should there be instances where my signature is required to prevent irrevocable loss of any intellectual property value, I propose that you have the patents transferred to an escrow agent, acceptable to both parties. **I will be willing to sign all relevant documents in favor of such an escrow agent. [Emphasis added.]**

This is not sufficient evidence of the inventor's refusal to sign.

Furthermore, Mr. Lindbo's attorney's, Mark Shub, corresponded with applicant's attorney in a letter dated 22 March 2000 indicating that Mr. Lindbo contacted him regarding a Declaration, Power of Attorney and Petition that applicant's attorney recently sent him. Mr. Shub's letter continues: "You have supplied no information as to who you represent and why you are requesting that Mr. Lindbo execute these documents. Without further information regarding this matter, Mr. Lindbo will not sign any of these documents."

Finally, before refusal can be alleged, it must be demonstrated that a complete copy of the application (i.e., specification, including claims, drawings and oath or declaration) was sent to non-signing inventor. See MPEP 409.03(d). It appears from Mr. Shub's letter that of these papers, only the declaration was sent to Mr. Lindbo.

Regarding item (5), Section 409.03(f) of the MPEP, **Proof of Proprietary Interest**, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office,

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (**in the English Language**) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324)...

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter. [Emphasis added.]

Here, Petitioner has not provided sufficient evidence to show that Mr. Lindbo has assigned his rights in the present application to the petitioner. The alleged assignment from Mr. Lindbo to Mirror Image Internet AB has not been furnished in the English language and further, appears to relate only to the Swedish priority application, not to the present application. The Agreement on the Sale and Purchase of a Business Operation, provided by petitioner, similarly does not adequately identify the present application.

In order to overcome the proprietary interest deficiency, a legal memorandum may be submitted by an attorney verifying familiarity with the laws of the jurisdiction involved. Facts in support of any conclusion that a court of competent jurisdiction would award title to the 37 CFR 1.47(b) applicant should be presented by way of affidavit(s) or declaration(s) of person(s) having firsthand knowledge thereof. See MPEP 409.03(f). The legal memorandum may be in declaration form (e.g. 37 CFR 1.68).

As for Item (6), Petitioner's declaration states that the present petition is necessary "to prevent abandonment of the application." Thus, item (6) is satisfied.

Accordingly items (2) and (5) and above have not been satisfied and applicant's petition must be dismissed.

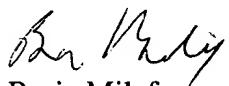
CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED WITHOUT PREJUDICE**.

If reconsideration on the merits of this petition is desired, a proper response must be

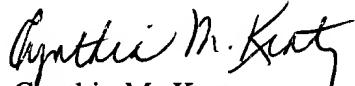
filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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